

## **REMARKS**

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-15, 17-26, 30-32, 47 and 48 were in the application, claims 1-15 and 17 were withdrawn, claims 16, 27-29 and 33-46 were cancelled, and claims 18-26, 30-32 and 48 remain pending and have been finally rejected.

Claims 18-26, 30-32 and 48 were rejected as being anticipated by U.S. Patent no. 5,708,828 to Coleman.

To have anticipation, each and every element of the claim must be found in a single prior art reference *W.L. Gore & Assoc. V. Garlock, Inc.* 721 F.2d 1540 (Fed. Cir. 1983). “Lack of novelty (often called ‘anticipation’) requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee” *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 U.S.P.Q.2D (BNA) 1101, 1103 (Fed. Cir. 1995) (emphasis added)

Anticipation requires the reference to describe all the elements of the claims, arranged as in the patented device. *Shearing v. Iolab Corp.*, 975 F.2d 1541, 1544-45, 24 U.S.P.Q.2D (BNA) 1133, 1136 (Fed. Cir. 1992) (emphasis added); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2D (BNA) 1913, 1920 (Fed. Cir 1989); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 U.S.P.Q. (BNA) 669, 673 (Fed. Cir. 1984). *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1349 (Fed. Cir., 1998).

Anticipation requires strict identity, without guessing what the reference discloses. *Dayco Products, Inc. V. Total Containment Inc.*, 329 F.3d 1358 (Fed. Cir. 2003). A claim cannot be “anticipated” by prior art that does not have all of the limitations in the claim. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000); *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1324 (Fed. Cir. 2006).

During examination, "claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990).

Although claims during examination are given their broadest reasonable interpretation in order to facilitate precision in claiming, that interpretation must be "consistent with the specification, [and] claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990); see also *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) ("[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question.")

As an initial matter, all the claims are directed to an "invoice routing apparatus" and the specific data associated with invoices and invoice processing is the subject of the applicants' invention. In particular, claims 18 and 48 specify that the input processor device is configured to:

add static data to the data corresponding to the received invoices when processed into said standard intermediate form, the static data added in dependence on the identity of the sender and the party being invoiced;

add dynamic data to the data corresponding to the received invoices when processed into the standard intermediate form, the dynamic data added in dependence on the identity of the sender and of the party being invoiced; and,

validate the data corresponding to the received invoices when processed into the standard intermediate form before transmission by said transmitter to the party being invoiced to ensure that the party being invoiced receives the data necessary for processing the invoice.

Thus, the purpose of adding the static and dynamic data in the present invention is to ensure that when converted to the standard intermediate form, all of the data necessary for the receiver of the invoice is provided in the data that is transmitted by the invoice transmitter in the final invoice to the party being invoiced. The validation of data specified in claims 18 and 48 is an overall validation of the data in the received invoices when processed into their standard intermediate form before transmission to the party being invoiced, with the selection of data and validation related specifically to the party being invoiced. Consequently, there can be significant diversity in the actual final invoices delivered, as each receiving party receives an invoice tailor to their particular needs.

The specific limitations above thus require a fair interpretation of the term "invoice" as virtually all the limitations include various invoice variations, such as the static and dynamic data selected relative to the "received invoice" and to the needs of "the party being invoiced", and the inventor had the right to direct his invention to invoice processing. Consequently, the examiners refusal to give proper weight and consideration to the use of the term "invoice" is error.

An inventor has the right to be his own lexicographer and to define the meets and draw claims to his invention, and every term in a claim must be given its proper meaning. See *Polaroid Corp. v. Eastman Kodak Co.*, 641 F. Supp. 828, 838, 228 USPQ 305, 312-13 (D. Mass. 1985), *aff'd*, 789 F.2d 1556, 229 USPQ 561 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 850 (1986) ("A patentee is entitled to choose his own terms and to insist on them so long as he is consistent and does not contravene any single established or accepted meaning."(emphasis added) As specified above, the broadest reasonable interpretation is tied to the specification, and this invention, as defined and claimed by the inventor, relates specifically to invoice processing, and the

specific data associated therewith. The examiners' interpretation that the claim relates to any "data" in general would certainly not be consistent in scope with what one skilled in the art would expect, as invoices are a specific subset of data with their own peculiar nature. Clearly the specification, which is the first source for interpretation is clear as to what an invoice is, and what the invention accomplishes relative to invoice processing.

To ignore that invoices are a specific subset of data with particular attributes reads out substantially the heart of the applicants' invention. No claim is drawn to "data" broadly, and the scope of the applicants' invention would not be read so broadly by either one skilled in the art or a court when seeking to enforce the patent, and so the scope expanded by the examiner is unreasonably broad.

To anticipate, a cited reference must disclose the specific claim features related to invoice processing, as the test requires "strict identity". As is clear, no such disclosure is found in Coleman and Coleman does not anticipate the applicants' invention. Consequently, claims 18-26, 30-32 and 48 are not anticipated by U.S. Patent no. 5,708,828 to Coleman.

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

/WJS/

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